

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

Ellen BARBARA, et al.

Art Unit: 3695

Serial No.: 09/903,284

Examiner: Ojo O. OYEBISI

Filed: July 11, 2001

For: METHOD AND SYSTEM FOR ONLINE PAYMENTS

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

The following is intended to be in compliance with the pilot program guidelines set forth in the July 12, 2005 OG Notice and is submitted with a Notice of Appeal. The undersigned respectfully requests careful consideration of the errors identified herein.

The outstanding rejections of claims 1-11, 17-44, and 50-72 are as follows:

(a) Claims 1-11, 17-44, and 50-72 under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,609,113 to O'Leary ("O'Leary").

**The Rejection of Claims 1-11, 17-44 and 50-72 in View of O'Leary Is Improper**

O'Leary does not teach each and every limitation of the pending claims. More specifically, O'Leary fails to teach "notifying the recipient by email at a recipient terminal by the payments engine of the payment before the recipient is enrolled at the on-line payments service," as recited in independent claim 1 and similarly recited in claims 34, 71, and 72.

O'Leary recites a system for effectuating payments electronically. More specifically, O'Leary recites paying individuals who are enrolled in an electronic funds transfer (EFT) system. But a user must have a virtual private lockbox in order to receive funds according to the system of O'Leary. See col. 11, lines 28-33 ("the PPP enhanced Wallet 215 is responsible for initiating the push of the credit to the merchant's account. In order to perform the credit push over the EFT, the PPP enhanced Wallet 215 *requires the merchant's payee information* that uniquely identifies the merchant's Virtual Private Lockbox (VPL) 235") (emphasis added). Thus, in order to conduct a transaction using the system recited in O'Leary, the merchant must register to establish a Virtual Private Lockbox, then the merchant is *required* to provide the merchant's payee information that uniquely identifies the Virtual Private Lockbox, and the PPP 227 transmits a purchase acknowledgement to the merchant's website 255. The VPL account number is *required* before a merchant may be paid by a customer, and in order to have any account number, the merchant must be registered to the PPP method of O'Leary. As another example, O'Leary recites, "Very little effort is required on the part of a merchant which only has to *publish its bank 275 and VPL deposit account 235 information on its website 255* or other public directory." Col. 18, lines 62-65 (emphasis added). As yet another example, O'Leary recites that "the user in step 5D selects the Pay Anyone option from the menu and is *prompted for the VPL number* of the account associated with the card." Col. 23, lines 4-6 (emphasis added). O'Leary consistently describes that the payee (merchant) must be enrolled and have a VPL account before receiving any payments. In contrast, claim 1 recites, and claims 34, 71, and 72 similarly recite, "notifying the recipient by email at a recipient terminal by the payments engine of the payment before the recipient is enrolled at the on-line payments service." By requiring the payee to be enrolled and have a VPL account, O'Leary teaches away from the present claims whereby the recipient is notified *before the recipient is enrolled*.

The Examiner responds that it is “a predictable result to send a notification to the recipient before enrollment since the system is a Pay Anyone EFT system.” See Advisory Action, page 3. Because the Examiner is asserting only O’Leary, the predictable result of O’Leary is exactly what it recites in its specification. The Examiner has not set forth a combination with other references that could generate other predictable results. *See KSR v. Teleflex*. O’Leary teaches away from “notifying the recipient by email at a recipient terminal by the payments engine of the payment before the recipient is enrolled at the on-line payments service.” In fact, in two separate telephone conversations, the Examiner agreed that O’Leary does not explicitly teach this claim limitation. So cannot O’Leary cannot yield another result when there is no combination with another reference.

The Examiner also appears to be relying on the term “anyone” in the product name “Pay Anyone” recited in O’Leary. But as described above, the descriptive sections of O’Leary all teach away from paying someone who does not have a VPL account. So, while O’Leary names this service “Pay Anyone,” there is no support in the description that the “Pay Anyone” feature can pay anyone who is not enrolled with a VPL account. There is no suggestion anywhere in O’Leary that a payee does not need to be enrolled. And this product name offers no teaching of how a payee can be notified before enrollment. Thus, O’Leary’s use of the term “anyone” refers to any person that is enrolled with a VPL account.

Further, the Examiner asserts that “the effect of this payment system is to ultimately pay anyone regardless of if they are enrolled in the system” and cites column 23, lines 18-34 in support. However, O’Leary states that the intended effect of the payment system is to ensure that “the transaction is conducted in a secure environment.” Col. 22, line 55-56. O’Leary assures that this transaction is conducted in a secure environment by making the VPL a limited function account that can only receive electronic payments. Col. 6, lines 4-9. Due to the limited functions of the VPL account, the merchant is not afraid to post an account number for the VPL publicly. If the EFT system of O’Leary were truly a “pay anyone” account, then an EFT payment may be sent to any account, whether it be a conventional checking account, a credit card, a limited function account like the VPL, or, most importantly, to someone who is not yet enrolled with an account. But, if O’Leary allowed a payment using the EFS system to be sent to a conventional checking account or to someone not currently enrolled with an account, then the transaction

would no longer be assuredly secure. Thus, even the intended effect of O'Leary teaches against "notifying the recipient by email at a recipient terminal by the payments engine of the payment before the recipient is enrolled at the on-line payments service," as recited in claim 1, and similarly recited in claim 34, 71, and 72.

The undersigned submits that claims 1, 34, 71, and 72 are allowable for the reasons stated above with respect to independent claims 1, 34, 71, and 72. In view of the remarks stated above, the undersigned representative respectfully requests that the rejections of claims 1-11, 17-44 and 50-72 be withdrawn and a notice of allowance is earnestly solicited.

**CONCLUSION**

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 19-3140.

Respectfully submitted,

Dated: September 7, 2012

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